

**REMARKS**

**INTRODUCTION**

The Office Action dated May 10, 2004 and the references cited therein have been carefully considered. In response, the applicant offers the following remarks and respectfully requests reconsideration and withdrawal of the rejections identified below.

**AMENDMENT UNRELATED TO PATENTABILITY**

Claim 3 has been amended by the foregoing amendments for clarity and not for reasons related to patentability. More particularly, claim 3 has been amended to correct a typographical error.

**OFFICE ACTION REJECTIONS**

Claims 9 and 15 are rejected under 35 U.S.C. Sec. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Claim 1-8, 10-14 and 16-24 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable in view of U.S. Patent No. 6,174,234 ("Seibert, Jr. et al.").

Claims 9 and 15 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over Seibert Jr. in view of U.S. Patent No. 6,159,095 ("Frohm et al.").

**SYNOPSIS OF PRIOR ART**

Seibert Jr. et al.: A jackpot device having a microprocessor that controls mechanical reel devices during a play mode. Prior to entering the play mode, the microprocessor enters an attract mode loop, during which tasks such as playing music, turning on lights, or simulating game play, are repeated until a player triggers the jackpot device to enter the play mode.

Frohm et al.: A game wherein apparently a plurality of squares are displayed and upon the calling of a specific number, the display is changed from displaying the keno square to the highlighted version indicating a specific keno number.

### **ARGUMENTS FOR PATENTABILITY**

Turning to the rejections of claims 9 and 15 under 35 U.S.C. 112, second paragraph, the Examiner stated that claims 9 and 15 recite one or more limitations that appear contradictory to the form of keno or bingo known to those skilled in the art, where numbers are selected randomly to establish a winning set. More particularly, the Examiner stated that the limitations of claims 9 and 15 seem contradictory to the language of independent claims 7 and 13, from which they respectively depend. Each such independent claim recites that keno (or bingo) spaces change in a predetermined, non-random sequence at a predetermined speed.

The applicant respectfully submits that claims 9 and 15, along with the independent claims 7 and 13 from which they respectively depend, do not recite contradictory subject matter when considered either alone or in combination. In short, the claims are directed to different modes of operation. With respect to the limitations recited in the two independent claims 7 and 13, keno (or bingo) spaces may change in a predetermined, non-random sequence while operating in a mode other than a game (or playing) mode. One example of a non-gaming mode would be an attract mode, during which keno (or bingo) spaces may also be displayed. Any changes in the display of such spaces would not be associated with the random selection of a number during play of the game. In turn, the limitations set forth in rejected claims 9 and 15 are directed to steps that may be taken by the controller during play of the game, or when a specific keno (or bingo) number is selected by the game.

Based on the foregoing distinctions, the applicant respectfully submits that claims 9 and 15 clearly and distinctly claim the subject matter that the applicant regards as the

invention and, accordingly, the above-identified rejections under 35 U.S.C. 112 should be withdrawn upon reconsideration.

Turning to the rejections based on the prior art, the applicant respectfully submits that Siebert Jr. et al. fails to present a prima facie case of obviousness, inasmuch as Siebert Jr. et al. fails to disclose or suggest all of the limitations recited in the independent claims. As set forth in MPEP section 2143.03, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

#### MISSING AND UNSUGGESTED ELEMENTS

All of the pending independent claims call for a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), to change to displaying a display object inside the first displayed items wherein the portions of the display object create an identifiable object.

In contrast, Siebert Jr. et al. teaches that an attract mode loop executed by a microprocessor for repetitive music playing, light activation, or simulated game play, to attract individuals to play the game. However, Siebert Jr. et al. does not further specify the nature of the sights and sounds that may be presented by execution of the attract mode loop. The leap in logic from Siebert Jr. et al's attract mode loop to the claimed manner of progressively changing the display inside game related display elements is too large to result in the claims being obvious.

Specifically, each of the independent claims specifies a manner in which an image is displayed that is distinct from the prior art. For instance, claim 1, and claims 2-6 by implication, recite a controller being programmed to display on the gaming display a plurality of playing cards where the playing cards change in a predetermined, non-random sequence at a predetermined speed from displaying one of card backs and card fronts to displaying a

portion of a display object inside the playing cards wherein the portions of the display object create an identifiable image. Siebert Jr. et al. fails to disclose or suggest each of the following elements and related function of claims 1-6:

- (i) the display of a plurality of playing cards where the playing cards change in a predetermined, non-random sequence at a predetermined speed;
- (ii) where the playing cards change from displaying one of card backs and card fronts to displaying a portion of a display object inside the playing cards; and,
- (iii) wherein the portions of the display object create an identifiable image.

Claim 7, and claims 8-12 by implication, also recite elements relating to the manner of displaying the portions of the display object inside the Keno number spaces. As a result, and for the reasons set forth hereinabove in connection with claims 1-6, Siebert Jr. et al. fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) of claims 7-12:

- (i) the display of a plurality of keno number spaces in a keno game where the keno number spaces change in a predetermined, non-random sequence at a predetermined speed;
- (ii) where the keno number spaces change from displaying keno numbers to displaying a portion of a display object; and,
- (iii) wherein the portions of the display object create an identifiable image.

Similarly, and for the reasons set forth hereinabove in connection with claims 1-6, Seibert Jr. et al. also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 13, and claims 14-17 by implication:

(i) the display of a plurality of bingo number spaces in a bingo game where the bingo number spaces change in a predetermined, non-random sequence at a predetermined speed;

(ii) where the bingo number spaces change from displaying bingo numbers to displaying a portion of a display object; and,

(iii) wherein the portions of the display object create an identifiable image.

For the reasons set forth hereinabove in connection with claims 1-6, Seibert Jr. et al. also fails to disclose or suggest the following steps and related functions (attracting players to the image and the specific game) recited in claim 18, and by implication claims 19 and 20:

(i) changing a portion of the playing cards from displaying a portion of playing cards to displaying a portion of a display object wherein the portions of the display object create an identifiable display object; and,

(ii) changing in a predetermined, non-random sequence at a predetermined speed an additional portion of the playing cards from displaying a portion of playing cards to displaying a portion of a display object wherein the portions of the display object create an identifiable display object.

Lastly, and for the reasons set forth hereinabove in connection with claims 1-6, Seibert Jr. et al. also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 21, and claims 22-24 by implication.

(i) a fourth memory portion physically configured with computer program instructions that would cause the gaming apparatus to change in a predetermined, non-random sequence at a predetermined speed from displaying the playing cards to displaying a portion of a display object inside the playing cards; and,

(ii) wherein the portions of the display object create an identifiable image.

Therefore, the claims are patentably distinct from the prior art.

#### DESIGN CHOICE

The Examiner states that selection of sights and sounds has been stated to constitute a matter of aesthetics, or a mere design choice. Nonetheless, it is respectfully submitted that the manner in which a gaming apparatus displays images is not a mere aesthetic design choice.

The Federal Circuit stated that one way to determine whether a claim element is a “design choice” is to review the operation or function that it performs. For example, in the case In re Chu, 66 F.3d 292, (Fed. Cir. 1995), the Federal Circuit decided that the structure and function of an element that is alleged to be a simple design choice (the placement of a catalyst) should be analyzed to determine if a claim is obvious. Id at 299. The court found that the applicant had submitted sufficient reasons why the placement of a catalyst was not a simple design choice and made a functional difference from the prior art, resulting in the claim being found as not obvious. Similarly, the Federal Circuit in the case In re Gal, 66 F.3d 299 (Fed. Cir. 1995) determined that the applicants semiconductor structure was not a simple design choice because it created a different function than that disclosed in the prior art, resulting in the claims being found to be not obvious.

In claims 1-6, displaying the portion of the display object inside the playing cards offering has a different function than the prior art by adding the possibility of attracting an individual to both the identifiable image as well as the nature of the game to be played. That is, displaying the identifiable image in this manner calls attention to the playing card nature of the game. In contrast, the attract mode taught by Siebert Jr. et al. is limited to music, lights, and simulated game play. To the extent that a graphic presentation is involved, there

is no suggestion that graphics or images be presented using the playing cards already displayed in the manner specified in claim 1.

Claim 7, and claims 8-12 by implication, also recite a display technique that has a different function than the prior art by offering the possibility of attracting an individual to both the identification image as well as the nature of the Keno game itself.

Claim 13, and claims 14-17 by implication, also recite a display technique that has a different function than the prior art by offering the possibility of attracting an individual to both the identification image as well as the nature of the bingo game itself.

Claim 18, and by implication claims 19 and 20 recite a display technique that has a different function than the prior art by adding the possibility of attracting an individual to both the identifiable image as well as the nature of the game to be played.

Claim 21, and claims 22-24 by implication recite a display technique that has a different function than the prior art by the possibility of attracting an individual to both the identifiable image as well as the nature of the game to be played.

Turning to the rejection of dependent claims 9 and 15 under 35 U.S.C. 103 as being unpatentable over Siebert Jr. et al. in view of Frohm et al., it is respectfully submitted that Frohm et al. also fails to disclose or suggest the elements or steps and related functions (attracting players to the image and the specific game) identified hereinabove as missing from the teachings of Siebert Jr. et al.

It is therefore respectfully submitted that claims 1-24 recite patentable subject matter over Siebert Jr. et al., either alone or in combination with Frohm et al. The elements missing from the prior art are not merely design choices but create a different and distinct function from the prior art. Reconsideration is respectfully requested.

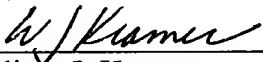
**CONCLUSION**

Based on the foregoing amendments and remarks, the applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, she is respectfully invited to telephone the undersigned.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300

By:

  
\_\_\_\_\_  
William J. Kramer  
Registration No. 46,229  
Attorney for Applicant

June 4, 2004